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Vb

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/208,619 12/08/98 HILLMAN

J PF-0229-1DIV

INCYTE PHARMACEUTICALS INC
PATENT DEPARTMENT
3174 PORTER DRIVE
PALO ALTO CA 94304

HM12/0322

EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

03/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/208,619

Applicant(s)

Hillman And Goll

Examiner

Alana M. Harris, Ph. D.

Group Art Unit

1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s) or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1 and 11-16 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1 and 11-16 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to a substantially purified human mitochondrial membrane protein, classified in class 530, subclass 350.
 - II. Claim 11, drawn to a purified antibody, classified in class 530, subclass 387.1.
 - III. Claim 12, drawn to a purified antagonist, classified in class 530, subclass 300.
 - IV. Claim 13, drawn to a method of treating cancer, classified in class 514, subclass 2.
 - V. Claim 14, drawn to a method for detecting a polynucleotide, classified in class 435, subclass 6.
 - VI. Claims 15 and 16, drawn to a method for identifying a specific agent, classified in class 435, subclass 7.31.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I-III are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups IV-VI differ in the method objectives, method steps and parameters and in the reagents used.

Art Unit:

Inventions of Group I and Group VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.E.P.. § 806.05(h)). In the instant case the protein of Group I can be used in *in vivo* therapeutics.

Inventions of Group III and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.E.P.. § 806.05(h)). In the instant case the antagonist of Group III can be used in *in vitro* diagnosis.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Attempts to reach Leanne C. Price by telephone on 3/20/00 to request an oral election to the above restriction requirement were unsuccessful.

Art Unit:

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, whose telephone number is (703) 306-5880.

A handwritten signature in black ink, appearing to read 'Nancy A. Johnson', with a long horizontal flourish extending to the right.

NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER